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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/573,029	03/12/2007	Willy Meier	09894.0016-00	4438
22852 7590 01/09/2008 FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			EXAMINER JOHNSON, MATTHEW A	
			ART UNIT 3682	PAPER NUMBER
			MAIL DATE 01/09/2008	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/573,029	Applicant(s) MEIER, WILLY	
	Examiner Matthew Johnson	Art Unit 3682	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 March 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 March 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>3/22/2006 & 10/17/2006</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

1. The certified copy of Application number EP-03405690.3, for which foreign priority has been claimed, appears to be missing page 2/2 of the drawings. The examiner requests that Applicant resubmit the certified copy so that support for the claimed subject matter of the instant application can be verified.

Drawings

2. It appears that figures 1a, 1b and 2 should be designated by a legend such as -- Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). Corrected drawings in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

3. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "second part further includes a cavity formed in its thickness" and "the second part carries a projection extending in the thickness of the wheel" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 1-7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 recites the limitation, "a first thickness situated towards the felly" in line 10 and, "a lesser second thickness situated towards an end of the finger" in line 11. The phrase "thickness situated towards" is unclear rendering the claim indefinite. How is the thickness situated towards the felly? How is the thickness situated towards the end of the finger? The direction of the thickness is unclear.

Claim 1 recites the limitation "the boundary" in 12. There is insufficient antecedent basis for this limitation in the claim.

Claims 4 and 5 recite the limitation "the wall" in 2. There is insufficient antecedent basis for this limitation in the claim.

Claim 7 recites the limitation, "a projection extending in the thickness of the wheel". The phrase, "extending in the thickness of the wheel" is unclear rendering the claim indefinite.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1-4 and 7, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Bornschein (USP-2,722,098).

Re clm 1: Bornschein discloses an escape wheel (1) comprising:

➤ A hub (center of wheel, Fig. 1)

- A felly (1) connected to the hub (Fig. 1)
- At least one tooth (5) arranged radially on the felly, the tooth having a root (base of tooth, Fig. 1) ending in a finger (extending from the base)
- Wherein the finger comprises a first part (top of 5, Fig. 5) having a first thickness situated towards the felly, and a second part (body portion of 5, Fig. 5) having a lesser second thickness situated towards an end of the finger, the boundary between the first and second parts defining a threshold (8) that, with an adjacent face of the second part (back side of 5, Figs. 2, 5 and 6) is configured to form an oil holder (C2 L16-19)

Re clm 2: Bornschein discloses the second thickness is approximately equal to one-half of the first thickness (Fig. 5).

Re clm 3: Bornschein discloses the distance between the threshold and the end of the tooth is approximately equal to the thickness of the wheel (Figs. 1 and 5).

Re clm 4: Bornschein discloses the wall of the oil holder formed by the threshold is concave (Figs 2 and 6).

Re clm 7: Bornschein discloses the second part carries a projection (10) extending in the thickness of the wheel.

8. Claims 1-4, 6 and 7, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Jeanmairret (USP-898,479).

Re clm 1: Jeanmairret discloses an escape wheel (A) comprising:

- A hub (10)

- A felly (12) connected to the hub (Fig. 1)
- At least one tooth (13) arranged radially on the felly, the tooth having a root (base of tooth, Fig. 1) ending in a finger (extending from the base)
- Wherein the finger comprises a first part (near 13, Fig. 2) having a first thickness situated towards the felly, and a second part (near 14, Fig. 2) having a lesser second thickness situated towards an end of the finger, the boundary (16, 17) between the first and second parts defining a threshold (15) that, with an adjacent face (14) of the second part is configured to form an oil holder (C1 L42-49)

Re clm 2: Jeanmairret discloses the second thickness is approximately equal to one-half the first thickness (Fig. 2).

Re clm 3: Jeanmairret discloses the distance between the threshold and the end of the tooth is approximately equal to the thickness of the wheel (Figs 1 & 2).

Re clm 4: Jeanmairret discloses the wall of the oil holder formed by the threshold is concave (Figs. 1 & 2).

Re clm 6: Jeanmairret discloses the second part (near 14, Fig. 2) further includes a cavity (15) formed in its thickness.

Re clm 7: Jeanmairret discloses the second part (near 14, Fig. 2) carries a projection (protruding end of 14) extending in the thickness of the wheel (A).

9. Claims 1-4, 6 and 7, as best understood, are rejected under 35 U.S.C. 102(b) as being anticipated by Marti et al. (USP-2,819,584).

Re clm 1: Marti discloses an escape wheel (1) comprising:

- A hub (Fig. 1)
- A felly (1) connected to the hub (Fig. 1)
- At least one tooth (2) arranged radially on the felly, the tooth having a root (base of tooth, Fig. 1) ending in a finger (extending from the base)
- Wherein the finger comprises a first part (between 2a & 2c) having a first thickness situated towards the felly (Fig. 3), and a second part (near 3) having a lesser second thickness situated towards an end of the finger (Fig. 3), the boundary between the first and second parts defining a threshold (3) that, with an adjacent face of the second part is configured to form an oil holder (C2 L35-42)

Re clm 2: Marti discloses the second thickness is approximately equal to one-half the first thickness (Fig. 3).

Re clm 3: Marti discloses the distance between the threshold and the end of the tooth is approximately equal to the thickness of the wheel (Fig. 1).

Re clm 4: Jeanmairet discloses the wall of the oil holder formed by the threshold is concave (C2 L18-22).

Re clm 6: Marti discloses the second part (near 3) further includes a cavity (3) formed in its thickness.

Re clm 7: Marti discloses the second part (near 3) carries a projection (protruding end of 2b) extending in the thickness of the wheel (1).

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claim 5, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Bornschein (USP-2,722,098) in view of Iwasawa (USP-3,709,324).

Re clm 5: Bornschein discloses all of the claim limitations as described above.

Bornschein does not disclose the wall has interruptions.

Iwasawa teaches an escapement mechanism having a wall (11a') that has interruptions (11b) for the purpose of preventing unintentional escapement of lubricating oil from the bearing surfaces (C1 L14-21 & C3 L44-48).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Bornschein to include interruptions in the wall of the oil holder, as taught by Iwasawa, for the purpose of preventing unintentional escapement of lubricating oil from the bearing surfaces (C1 L14-21 & C3 L44-48).

12. Claim 5, as best understood, is rejected under 35 U.S.C. 103(a) as being unpatentable over Marti et al. (USP-2,819,584) in view of Iwasawa (USP-3,709,324).

Re clm 5: Marti discloses all of the claim limitations as described above.

Marti does not disclose the wall has interruptions.

Iwasawa teaches an escapement mechanism having a wall (11a') that has interruptions (11b) for the purpose of preventing unintentional escapement of lubricating oil from the bearing surfaces (C1 L14-21 & C3 L44-48).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to have modified the device of Marti to include interruptions in the wall of the oil holder, as taught by Iwasawa, for the purpose of preventing unintentional escapement of lubricating oil from the bearing surfaces (C1 L14-21 & C3 L44-48).

Conclusion

13. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew Johnson whose telephone number is 571-272-7944. The examiner can normally be reached on Monday - Friday 8:30a.m. - 5:00p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Ridley can be reached on 571-272-6917. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

MJ

MJ 1/3/2008

A handwritten signature in black ink, appearing to read 'Richard Ridley', is written over a horizontal line.

RICHARD RIDLEY
SUPERVISORY PATENT EXAMINER